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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,997	11/12/2003	Andrew S. Lilly	91330.095203	6544

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EXAMINER

HAN, JASON

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/705,997	Applicant(s) LILLY, ANDREW S.	
	Examiner Jason M. Han	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1 and 6 are objected to because of the following informalities: Applicant recites the limitation "the interior of the boat". There is insufficient antecedent basis for this limitation in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cribbs (U.S. Patent 5613886).

3. With regards to Claim 1, Cribbs discloses a trolling motor assembly including:

- A motor control compartment [Figure 1: (14)];
- A motor/propeller assembly [Figure1];
- A shaft [Figure 1]; and
- A light assembly [Figure 1: (16)] that is attached to the motor control compartment at a desired preference [Column 2, Lines 50-53; Column 3, Lines 59-67; Column 5, Lines 9-10].

4. With regards to Claim 2, Cribbs discloses the motor control compartment including a motor control compartment casing [Figure 1: (14)] and the light assembly mounted upon the motor control compartment casing [Figures 1-2: (18)].

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5. With regards to Claim 4, Cribbs discloses the light assembly being powered by a DC power source [Figure 2: (42)].

6. With regards to Claim 5, Cribbs discloses the light assembly being powered by the same device as the trolling motor [Column 6, Lines 5-7].

7. Claims 6-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cribbs (U.S. Patent 5613886).

8. With regards to Claim 6, Cribbs discloses a trolling motor assembly including:

- A motor control compartment [Figure 1: (14)];
- A motor/propeller assembly [Figure1];
- A shaft [Figure 1]; and
- A light assembly [Figure 1: (16)] that is attached to the motor control compartment at a desired preference [Column 2, Lines 50-53; Column 3, Lines 59-67; Column 5, Lines 9-10].

9. With regards to Claim 7, Cribbs discloses the motor control compartment including a motor control compartment casing [Figure 1: (14)] and the light assembly mounted upon the motor control compartment casing [Figures 1-2: (18)].

10. With regards to Claim 9, Cribbs discloses the light assembly being powered by a DC power source [Figure 2: (42)].

11. With regards to Claim 10, Cribbs discloses the light assembly being powered by the same device as the trolling motor [Column 6, Lines 5-7].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cribbs (U.S. Patent 5613886) as applied to Claims 1 and 6 respectively above.

Cribbs discloses the claimed invention as cited above. In addition, Cribbs discloses a motor control compartment casing [Figure 1: (14)] whereby the light assembly is mounted upon the motor control compartment casing [Figures 1-2: (18)], but does not specifically teach the light being contained within a substantially translucent casing such that light passes there through.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the light assembly within the casing, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). In this case, making integral the casing and light assembly provides for a more compact device.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to then incorporate the casing out of a translucent material, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design

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choice. *In re Leshin*, 125 USPQ 416. In this case, providing a translucent casing would ensure appropriate illumination from the light assembly contained therein. Applicant corroborates the preferred material being translucent, "A further embodiment is contemplated wherein the lighting means is contained within the motor compartment and portion of the motor compartment housing is the appropriate material to permit the passage of light through the motor compartment [Page 3, Line 23 – Page 4, Line 3]."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

US Patent 3502861 to Evans;

US Patent 4884173 to Cassidy;

US Patent 5980073 to Whipple;

US Patent 6170969 to Dumse;

US Patent 6174078 to Ohm et al;

US Patent 6200009 to Schulte;

US Patent 6386740 to Grissom;

US Patent 6474851 to Baley;

US Patent 6644829 to Tracy et al;

US Publication 2004/0257822 to Hopkins.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (3/1/2005)



JOHN ANTHONY WARD
PRIMARY EXAMINER